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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,445	06/26/2003	Shuichi Sugita	2204-031174	2951

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EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,445

Applicant(s)

SUGITA ET AL.

Examiner

Kevin R Kruer

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1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are drawn to a laminate wherein the "clear paint film does not reduce the brightness of the base metal sheet." Said limitation is herein interpreted to mean that the energy of the incident light  $L_{out}$  of the clear paint is substantially equal to the energy of the incident light  $L_{in}$ . However, it is not clear how the term "substantially equal" should be interpreted especially in light of the disclosure that the clear paint layer may comprise pigment (bottom of page 9). Furthermore, said limitation is held to be indefinite because it is not clear how the incident light  $L_{in}$  and  $L_{out}$  are measured.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims are drawn to a laminate wherein the "clear paint film does not reduce the

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brightness of the base metal sheet.” Said laminate comprises an interference coloring pigment in the clear paint film (claim 1) that give the laminate an interference coloring effect. However, the prior art (US 4,615,940) suggests that the interference coloring effect cannot be obtained with a non-pigmented clear-paint film. Specifically, ‘940 teaches that the paint film must have a color value of N-4 to N-8 on the Munsell color chart (col 5, lines 20+) in order for opalescent effected to be perceptible (col 5, lines 35+). Thus, it is unclear how applicant is able to obtain said interference coloring effect outside the color value ranges disclosed to be critical by the prior art.

### ***Claim Rejections - 35 USC § 102***

Note: for purposes of examination, the term “flake” is understood to be a “flattened piece” as defined by Merriam Webster’s Collegiate Dictionary.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The rejection of claims 1-3 and 6-8 under 35 U.S.C. 102(b) as being anticipated by Pfenninger et al (US 5,025,041) has been overcome by amendment. Pfenninger teaches that the composition should comprise an azo pigment (col 1, line 65). Said pigment will absorb a specific wavelength part of the light  $L_{in}$  (see specification page 1, lines 17+). Thus, the coating reduces the brightness of the base metal. Specifically, the energy of the incident light  $L_{out}$  will be less than the energy of the incident light  $L_{in}$  (see top of page 6).
3. The rejection of claims 1-3, 6, and 7 under 35 U.S.C. 102(b) as being anticipated by Panush et al (US 4,547,410) has been overcome by amendment. Panush teaches that the basecoat should comprise a pigment (see explanation above).

***Claim Rejections - 35 USC § 103***

4. The rejection of claim 9 under 35 U.S.C. 102(b) as being anticipated by Pfenninger et al (US 5,025,041), as applied to claims 1-3 and 6-8 above, and further in view of Baumgart et t (US 6,534,185) has been overcome by amendment.
5. The rejection of claims 4 and 5 under 35 U.S.C. 103(a) as being unpatentable over Panush et al (US 4,547,410), as applied to claims 1-3, 6, and 7 above, and further in view of JP 62057676 (herein referred to as Kansai) has been overcome by amendment.
6. The rejection of claims 1-3 and 6-9 under 35 U.S.C. 103(a) as being unpatentable over Panush et al (US 4,615,940) in view of Pfenninger et al (US 5,025,041) has been overcome by amendment.

***Response to Arguments***

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,063,258 teaches a two-coat system for use on metal substrates comprising an unpigmented pearlescent coating and a clear coat.
8. In order to expedite prosecution, applicant is encouraged to call the examiner and schedule an interview at their earliest convenience.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer  
Patent Examiner-Art Unit 1773